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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,093

12/07/2006

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7055 7590 05/22/2008
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EXAMINER

LOEWE, SUN JAE Y

ART UNIT

PAPER NUMBER

1626

NOTIFICATION DATE

DELIVERY MODE

05/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/575,093	Applicant(s) MURAKATA ET AL.	
	Examiner SUN JAE Y. LOEWE	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-13,16,24,34,35,38,42,43,48,51 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☒ Claim(s) 1,8-13,24,34,35,38,42,43,48,51 and 53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-3-2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 8-13, 16, 24, 34, 35, 38, 42, 43, 48, 51 and 53 are pending in the instant application. Claims 2-7, 14, 15, 17-23, 25-33, 36, 37, 39-41, 44-47, 49, 50, 52 and 54-56 were cancelled by amendment filed on March 3, 2008.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on March 3, 2008 was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS was considered. A signed copy of form 1449 is enclosed herewith.

Response to Amendment

3. The claim amendments filed on March 3, 2008 were fully considered. The amendment successfully overcomes the following grounds of rejection, which are hereby withdrawn: i) 35 USC 112 1st paragraph rejection (written description); ii) 35 USC 112 1st paragraph rejection (enablement), with respect to all claims except claim 16; iii) 35 USC 112 2nd paragraph rejection; iv) 35 USC 101 rejection; v) 35 USC 102 rejection.

4. The 35 USC 112 1st paragraph (enablement) rejection is maintained with respect to claim 16 and hereby made FINAL. The claim still recites "antitumor agent."

5. The objection to claims 1, 8-13 and 16 for containing non-elected subject matter outside of the scope of the elected Group I (restriction requirement dated July 18, 2007)

- I. Group I, claim(s) 1, 2, 4-19, 23-28 and 34-56 drawn to products of Formula I and process of using products of Formula I, wherein Z=sulfur, R¹=phenyl, R²=C(=W')R¹² with W'=oxygen and R¹²=H or unsubstituted alkyl.

is maintained. The restriction requirement was made FINAL in the office action dated September 4, 2007. Applicant is requested to delete the non-elected subject matter.

5. The objection to claims 1, 8-13, 16, 24, 34, 35, 38, 42, 43, 48, 51 and 53 for containing non-elected subject matter based on the provisional election of species is maintained. Currently the scope of examination is limited to the elected species of Compound 49 (Table 1, page 46). However, upon allowance of the generic claims, Applicant is entitled to rejoinder and examination of further species within the scope of

- I. Group I, claim(s) 1, 2, 4-19, 23-28 and 34-56 drawn to products of Formula I and process of using products of Formula I, wherein Z=sulfur, R¹=phenyl, R²=C(=W')R¹² with W'=oxygen and R¹²=H or unsubstituted alkyl.

6. Applicant's amendment to the claims necessitated the new ground of objection set forth herein, Section 7.

Claim Objections

7. Claim 42 objected to for being an essential duplicate of claim 24.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe, Ph.D./
5-14-2008

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626